

### **REMARKS**

Claims 37, 38 and 44 are amended. Claims 37-38, 44-45, 47-51 and 53-58 are pending in the application.

Claims 37-38, 44-45, 47-51 and 53-58 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. The Examiner indicates that the specification does not sufficiently support the phrase "non-iron majority metal". Without admission as to the propriety of the Examiner's rejection, independent claims 37 and 38 are each amended to recite a list of elements from which the majority metal or majority element is selected. Accordingly, applicant respectfully requests withdrawal of the § 112 rejection of independent claims 37 and 38 and their corresponding dependent claims in the Examiner's next action.

Claims 38, 48-51, 53-55 and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlop, U.S. Patent No. 5,780,755. The Examiner is reminded by direction to MPEP § 2143 that a proper obviousness rejection has the following three requirements: 1) there must be some suggestion or motivation to modify or combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the combined references must teach or suggest all of the claim limitations. Claims 38, 48-51, 53-55 and 58 are allowable over Dunlop for at least the reason that Dunlop fails to disclose or suggest each and every element in any of those claims.

Independent claim 38 recites an alloy comprising a majority element selected from the recited group, where the alloy comprises a first element selected from Ni and Ag, and a

second element selected from the group consisting of Al, Cu, Pt, Au, Mo and Ta. Dunlop discloses processing of various metals which can comprise copper, silicon, zirconium, titanium, tungsten, platinum, gold, niobium, rhenium, scandium, cobalt, molybdenum, hafnium and alloys thereof (col. 4, ll. 12-41). As indicated in applicant's previous response, Dunlop fails to disclose or suggest the claim 38 recited alloy having a first element selected from Ni and Ag. Although this position was clearly stated in applicant's previous response, such is not addressed by the Examiner in the present action. The present Action is therefore not in accordance with the completeness requirement of MPEP § 707.07. Further, a *prima facie* case of obviousness has not been established relative to claim 38. Accordingly, claim 38 is allowable over the cited reference.

Dependent claims 48-51, 53-55 and 58 are allowable over Dunlop for at least the reason that they depend from allowable base claim 38.

Claims 37, 44-45, 47 and 56-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlop as combined with "Aluminum and Aluminum Alloys" pp. 290-292. As amended, independent claim 37 recites an alloy comprising one or both of Ni and Ag, and having a majority metal selected from the group consisting of Al, Ti, Cu, Ta, Ni, Mo, Au, Ag, Pt, and alloys thereof. As indicated above, Dunlop does not disclose or suggest an alloy comprising at least one of Ni and Ag. As indicated at page 5 of the present Action, "Aluminum and Aluminum Alloys" is relied upon as disclosing methodology of solution heat treating and production of a homogenous structure. However, the solution heat treating disclosed by "Aluminum and Aluminum Alloys" does not contribute toward suggesting the claim 37 recited alloy comprising one or both of Ni and Ag. Accordingly, as combined with Dunlop, "Aluminum and Aluminum Alloys" does not contribute toward suggesting the claim

37 recited alloy having a majority metal selected from the recited group and comprising one or both of Ni and Ag. Independent claim 37 is therefore not rendered obvious by the cited combination of Dunlop and "Aluminum and Aluminum Alloys" and is allowable over these references.

Claim 44 is amended to properly depend from independent claim 37. Dependent claims 44-45, 47 and 56-57 are allowable over Dunlop and "Aluminum and Aluminum Alloys" for at least the reason that they depend from allowable base claim 37.

For the reasons discussed above claims 37-38, 44-45, 47-51 and 53-58 are allowable. Accordingly, applicant respectfully requests formal allowance of such pending claims in the Examiner's next action.

Respectfully submitted,

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